REMARKS

Applicants respectfully request further examination and reconsideration in view of the instant response. Claims 1-26 remain pending in the case. Claims 1-26 are rejected. The Examiner is thanked for performing a thorough search.

REQUEST FOR ENGLISH TRANSLATION OF CITED JAPANESE PATENT REFERENCE

Applicants respectfully point out that paragraph 3 of the Office Action appears to state that Claims 4 and 16 are rejected "... in view of Mihata..." Therefore, it appears to Applicants, that the Office Action is rejecting Claims 4 and 16 on the basis of the entire Mihata reference. MPEP 706.02 II states, "...it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action" (emphasis added). For the sixth time during the prosecution of the current patent application, Applicants have respectfully requested an English translation of the cited non-English reference, Japanese Patent 403010379 by Mihata et al., hereinafter referred to as the "Mihata" reference.

In the event that Mihata is again cited by the Examiner in rejecting the claims, in order to fully appreciate the scientific teachings of Mihata, Applicants request that the Examiner provide a complete translation of Mihata in order to fully understand its teachings.

35 U.S.C. §103(a)

CLAIMS 1-3, 5-15 and 17-26

Claims 1-3, 5-15 and 17-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent 6,059,842 by Dumarot et al., (hereinafter referred to as "Dumarot") in view of United States Patent 6,342,985 by Clare, (hereinafter referred to as "Clare"). Applicants have reviewed the cited references and respectfully submit that the embodiments of the present invention as recited in Claims 1-3, 5-15 and 17-26 are neither taught nor suggested by Dumarot or Clare, alone or in combination.

Independent Claim 1 recites,

> A computer-implemented method for enhancing performance of a computer system, comprising:
> electronically deriving relationships over time between monitored system variables and monitored performance of said computer system;
> automatically generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction; and
> adjusting at least one of said system variables based on said generated number of rules to enhance the performance of said computer system.

"As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries" including "[a]scertaining the differences between the claimed invention and the prior art" (MPEP 2141(II)). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious" (emphasis in original; MPEP 2141.02(I)). Applicants note that "[t]he prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art" (emphasis added; MPEP 2141(III)).

Applicants understand Dumarot to teach that a user specifies levels of optimization. A user specified level of optimization controls which application settings are used to optimize an application. For example, the user can cause a system to maximize performance and sacrifice graphic quality by entering a value of "True" for the suppressAutoRefresh parameter, which indicates redrawing of graphics should be suppressed. Applicants further understand Dumarot to teach that a user specifies rules. A user specified rule is used to optimize and/or to make recommendations to the user for optimization.

Thus, Applicants do not understand Dumarot to teach "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system; automatically generating a number of rules

based on said derived relationships, wherein said number of rules are generated without requiring human interaction; and adjusting at least one of said system variables based on said generated number of rules to enhance the performance of said computer system," (emphasis added) as recited by Claim 1.

Applicants do not understand Clare to remedy the deficiencies in Dumarot in that Applicants do not understand either Dumarot or Clare, alone or in combination, to teach or suggest, "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system; automatically generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction; and adjusting at least one of said system variables based on said generated number of rules to enhance the performance of said computer system," (emphasis added) as recited by Claim 1.

For example, Applicants understand Clare to teach various relationships, such as a known relationship between temperature and torque factor, and equations that can be used for calculating a value for $K_{t\ event}$ (torque factor at a future time/event) instead of calculating a value for the conventional $K_{t\ recall}$ (torque factor performed at start-up). Applicants also understand Clare to teach using the $K_{t\ event}$ value instead of using the conventional $K_{t\ recall}$ value in a seek algorithm.

Thus, Applicants do not understand Clare to teach "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system; automatically generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction; and adjusting at least one of said system variables based on said generated number of rules to enhance the performance of said computer system," (emphasis added) as recited by Claim 1.

The Office Action states in the second paragraph of page 3, "However, Clare teaches automatically generating rules without requiring human interaction, deriving relationships over time ..." At the end of the first paragraph on page 4, the Office Action states, "Clare does not teach determine relationship with human interaction, this relationship is automatically generated without requiring the human interaction." First, to clarify the record, the Office Action has misquoted the embodiment recited by Claim

1. Second, the Office Action appears to be confusing relationships with rules as recited by Claim 1. Applicants respectfully point out that Claim 1 recites, "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system; generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction" (emphasis added). Note that the rules are generated based on the relationships and it is the rules that are generated without requiring human interaction.

For at least these reasons, Applicants believe that independent Claim 1 should be patentable. For similar reasons, Independent Claims 12, 14, and 24 should be patentable. Claims 2, 3 and 5-11 depend from independent Claim 1, Claim 13 depends from independent Claim 12, Claims 15 and 17-23 depend from independent Claim 14, and Claims 25 and 26 depend from independent Claim 24. The dependent claims include all of the features of their respective independent claims. Further the dependent claims include additional features which further make them patentable. Therefore, the dependent claims should be patentable for at least the reasons that the respective independent claims should be patentable.

35 U.S.C. §103(a)

Claims 4 and 16

Claims 4 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dumarot in view of Clare, further in view of the Japanese Patent 403010379 by Mihata et al., hereinafter referred to as the "Mihata" reference. Claim 4 depends from independent Claim 1 and Claim 16 depends from independent Claim 14. Applicants have reviewed the cited references and respectfully submit that the embodiments of the present invention as recited in Claims 4 and 16 are patentable over Dumarot, Clare, and Mihata, alone or in combination.

As described above in the discussion of the rejection of Claims 1-3, 5-15 and 17-26, Applicants do not understand the combination of Dumarot in view of Clare to teach, disclose or suggest the claimed embodiments of the present invention as recited in independent Claims 1 and 14. Moreover, Applicants submit that Mihata does not overcome the deficiencies in Dumarot and Clare. Applicants understand Mihata to teach a design rules verifying system. Applicants do not understand Mihata, alone or in

combination with Dumarot and Clare, to teach or suggest a method for enhancing performance of a computer system, including "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system," or "automatically generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction," as recited by Claim 1. Therefore, independent Claim 1 should be patentable over the combination of Dumarot in view of Clare, further in view of Mihata. For similar reasons Claim 14 should be patentable over the combination of Dumarot in view of Clare, further in view of Mihata. Claim 4 depends on independent Claim 1. Claim 16 depends on independent Claim 14. Applicants respectfully submit that Claims 4 and 16 overcome the rejection under 35 U.S.C. § 103(a) as these claims are dependent on allowable base claims.

Applicants respectfully point out that the rejections based only on Mihata are based only on the Abstract of Mihata, which is the only portion of Mihata that is translated into English. Applicants respectfully point out that paragraph 3 of the Office Action appears to state that Claims 4 and 16 are rejected "...and in view of Mihata..." Therefore, it appears to Applicants, that the Office Action is rejection Claims 4 and 16 on the basis of the entire Mihata reference while only providing a translation of Mihata's abstract. MPEP 706.02 II states, "...it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action" (emphasis added). For the sixth time during the prosecution of the current patent application, Applicants have respectfully requested an English translation of the cited non-English reference, Japanese Patent 403010379 by Mihata et al., hereinafter referred to as the "Mihata" reference.

In the event that Mihata is again cited by the Examiner in rejecting the claims, in order to fully appreciate the scientific teachings of Mihata, Applicants request that the Examiner provide a complete translation of Mihata in order to fully understand its teachings.

CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1-26 overcome the rejections of record and, therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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